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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,151	09/03/2003	Kingman Yee	018158-013211US	6519
20350	7590	03/11/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			FARAH, AHMED M	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/655,151	Applicant(s) YEE ET AL.	
	Examiner Ahmed M Farah	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-45 and 57-77 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 41, 42, 44, 57 and 71-77 is/are rejected.
- 7) ☒ Claim(s) 43, 45, and 58-70 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03/11/2004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. **Amendments to the Specification:**

Please replace the paragraph at page 1, lines 4-6 with the following amended paragraph:

This application is a divisional of U.S. Patent Application No. 09/805,737, filed March 13, 2001, now U.S. Patent No. 6,673,062, which is based on and claims the benefit of U.S. Provisional Patent Application No. 60/189,633, filed March 14, 2000, the entire disclosures of which are incorporated herein by reference.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 41 is rejected under 35 U.S.C. 102(b) as being anticipated by Delp et al.
U.S. Pat. No. 5,871,018.

Delp et al. disclose a method for fitting a three-dimensional target function by providing a two-dimensional basis function representing a 3-D profile, which has a symmetry with respect to the 2-D pattern as presently claimed (see Fig. 1; col. 5, lines 53-57; and claim 8).

4. Claim 41, 42, 44, and 57 are rejected under 35 U.S.C. 102(e) as being anticipated by Stewart et al. U.S. Pat. No. 5,903,458.

Stewart et al. disclose a method for fitting a three-dimensional target function by providing a two-dimensional basis function representing a 3-D profile, which has a symmetry with respect to the 2-D pattern as presently claimed (see Fig. 1; col. 5, lines 53-57; and claim 8).

5. Claims 41, 42, 44, and 57 are rejected under 35 U.S.C. 102(e) as being anticipated by Clapham U.S. Pat. No. 6,245,059 B1.

Clapham discloses apparatus and methods of use for selectively ablating corneal tissue to improve the vision of a patient having corneal irregularities. His correction method includes the steps of: determining the irregularities of the cornea being treated; determining a suitable/desired profile for the correction; providing a treatment library and treatment table, which include functions representing the desired corneal profile; and directing ablative laser pulses to the cornea to provide the desired correction (corneal curvature).

Clapham teaches that 'the particular therapy profile or profiles applied to a patient's eye are provided by mapping the cornea of the patient using different scanning techniques.' See Col. 3, lines 6-14. In this Office Action (OA), Clapham's method of

mapping/determining the corneal irregularity is treated to be analogous to the step of *“providing a 2-dimensional basis function representing a 3-dimensional treatment profile”* as presently claimed. Clapham further teaches that overlapping laser shots are directed to the regions of the cornea being treated.

Hence, the Examiner's position is that Clapham first determines the desired treatment (provides a basis function) by scanning the corneal surface, produces a library of treatment profile (provides a target function), and finally fits the treatment profile (target function) with the desired treatment (bases function) to obtain a treatment table including scanning spot locations and characteristics of the overlapping scanning spots of the laser beam.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 71-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clapham U.S. Pat. No. 6,245,059 B1.

Although Clapham, described above, does not teach the recited fitting techniques, the use data fitting techniques, such as least square method is well known in the art. Therefore, at the time of the applicant's invention, it would have been obvious

to one skilled in the art to use a suitable fitting technique so as to get best fit the data of the basis function with the target profile.

Allowable Subject Matter

7. Claims 43, 45 and 58-70 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

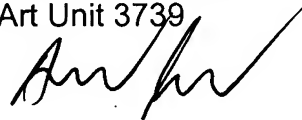
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See U.S. Patent No. 6,599,285 to Lieberman et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ahmed M Farah whose telephone number is (571) 272-4765. The examiner can normally be reached on Mon-Thur. 9:30 AM-7:30 PM, and 9:30 AM - 6:30 PM on every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M DVorak can be reached on (571) 272-4768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ahmed M Farah
Primary Examiner
Art Unit 3739

A handwritten signature in black ink, appearing to read 'Ahmed M Farah', is written over the printed name and title.

March 6, 2005.